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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/010,246
Filing Date: December 06, 2001
Appellant(s): SIXTO ET AL.

Rebecca A. Tie
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/10/09 appealing from the Office action mailed 5/7/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,620,452	YOON	4-1997
5,222,961	NAKAO et al.	6-1993

4,719,917 BARROWS et al. 1-1988

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

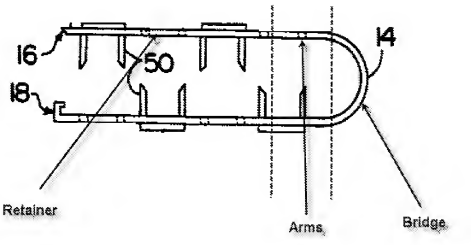
> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 17, 18, 21-23, 25 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,620,452 to Yoon.

Yoon discloses a surgical clip, as shown in the attached Fig. 10 below, which comprises a first arm; a second arm that is substantially parallel to the first arm; and a bridge connecting said first and second arms to form a substantially U-shaped structure. The arms also include a retainer portion attached thereto capable of penetrating tissue with force. The length of the retainer is fully capable of being at least 3.14 times the distance between the arms when the arms are substantially parallel (depending on how far the hashed line is manipulated). The retainer is also capable of being deformed (Fig. 4). Yoon also discloses the retainer having a tip portion **16** that has a thickness smaller than the thickness of the arm; wherein the tip portion **16** is viewed as "sharp" (pointed). The clip of Yoon is also fully capable of retaining its substantially U-shaped configuration prior to, throughout, and subsequent to application (the amount of separation between the two arms merely depends on the amount of force used to press

the arms together). The clip is also designed to be used with a clip applier capable of housing multiple clips (col. 3, ll. 41-59).

FIG. 10



Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 3, 7, 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon, as applied to the rejections above, and in further view of US 5,222,961 to Nakao et al.

Yoon discloses all the limitations of the claims except for each arm having a retainer that has a sharp tip and the same length. However, the use of such retainers are well known in the art, as taught by Nakao in Figs. 9-12. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the retainer of Nakao in the device of Yoon since it has been held that a simple substitution of one known element for another equivalent element would provide predictable results and involve only routine skill in the art. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1396 (2007).

5. Claims 5, 6, 8-10, 26, 27 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon (and in view of Nakao et al.) and in further view of US 4,719,917 to Barrows et al.

Yoon (and Yoon as modified by Nakao) discloses all the limitations of the claims except for the retainer being decouplable form the arms. However, Barrows discloses a similar type of clip/stapling device, wherein the retainer portion of the device is capable of being decoupled from the arms, and wherein the arms have a slot for holding the retainer portion (Fig. 10). This type of arrangement allows for the device to be easily removed from the patient with minimum discomfort (col. 1, lines 60-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Yoon (Yoon/Nakao) to have decouplable retainers

because it would allow the device to be removed from the patient with minimum discomfort.

(10) Response to Argument

With regards to the 35 USC 102(b) rejections over Yoon, the appellant argued that Yoon allegedly fails to disclose a "static U-shaped structure that is retained prior to, throughout and subsequent to application of the clip". It was alleged that the term "static" means that "it retains substantially the same initial U-shaped structure prior to, throughout, and subsequent to application such that the shape and diameter of the U-shape does not change at any time in any relevant way" (page 15 of the Brief). However, the examiner does not believe the term to be as limiting as defined by the appellant.

In fact, the broadest reasonable interpretation for the limitation "a static U-shaped structure" simply means that the structure maintains a U-shape configuration (a static shape). The limitation does not impose any structural size or dimension, but merely describes the shape of the structure.

As seen in Fig. 10 or 12 of Yoon, the clip defines a bridge with a U-shaped configuration in an undeployed state. Fig. 15 shows the clip in a deployed state, wherein the clip still defines a bridge that maintains a U-shaped configuration. It is also noted that the clip of Yoon is fully capable of being applied using a clip applier/forceps that can provide even pressure to the length of the clip arms, which would allow the clip arms to remain substantially parallel as pressure is applied. This "in-between state" would also have the clip defining a bridge that maintains a U-shaped configuration.

The appellant does argue that Yoon fails to teach the arms remaining parallel "throughout" the application, which is the aforementioned "in-between state" above. However, it is noted that the claims of the invention are directed towards a device-type invention (and not methodology) and that the device of Yoon is fully capable of being applied with the arms remaining substantially parallel. This could be done via a manual application, such as being compressed evenly between the fingers of a surgeon, or with a device such as a clip applier or a forceps. Therefore, Yoon discloses a clip that is fully capable of maintaining a U-shaped configuration prior to, throughout, and subsequent to application (undeployed state, in-between state, and deployed state).

With regards to the rejections under 35 USC 103(a) under Yoon in view of Nakao or Barrows, the appellant states that the 103 rejections stand or fall with the 102 rejections above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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/(Jackie) Tan-Uyen T. Ho/

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